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EXAMINER	
WILDER, PETER C	

ART UNIT	PAPER NUMBER
2623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/085,886	KIKINIS, DAN	
	Examiner	Art Unit	
	Peter C. Wilder	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-17 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 2/27/200 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Note to Applicant

Art Units 2611, 2614 and 2617 have changed to 2623. Please make all future correspondence indicate the new designation 2623.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claims 7-12 define a machine - readable medium embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized"). The examiner should suggest amending the claim to embody the program on "computer-readable medium" or equivalent in order to make the claim statutory. For example, the claimed "**A machine-readable medium that provides instructions that, when**

executed by a machine, cause the machine to perform operations" should be changed to the following:

-- A computer-readable medium encoded computer executable instructions, that when executed by the computer, cause the computer to perform operations --.

Claims 7-12 are drawn to functional descriptive material recorded on a machine readable-medium. The specification defines the machine-readable medium to be a signal as follows:

(a) page 13, lines 19 –20, indicates - "Further, the instructions can be downloaded into a computing device over a data network in a form of compiled and linked version".

(b) page 13, line 21 – page 14, line 3, indicates - "..media...and electrical, optical, acoustical and other forms of propagated signals (e.g. carrier waves, infrared signals, digital signals etc.)".

A "signal" embodying functional descriptive material is neither a process ("actions"), machine, manufacture nor composition of matter (i.e., a tangible "thing") and therefore does not fall within one of the four statutory categories of § 101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material.

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory. The examiner suggests amending the claim to *include* the disclosed tangible computer

readable media, while at the same time *excluding* the intangible media such as signals, carrier waves, etc defined in the specification. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13, and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Knee et al. (U.S. 2002/0095676 A1).

Referring to claim 13, Knee teaches a system (Figure 2) comprising:

a first unit (Figure 1 element 44) to select a first advertisement based on a demographic profile based on a second set of categories of broadcasted programs to which a category from a first set of categories of broadcasted programs was added in response to a selecting of the category from the first set or a broadcasted program viewing device being tuned, for a period of time at least equal to a first predetermined threshold, to at least one broadcasted program predetermined to be in the category from the first set (Paragraph [0050] and Paragraph [0035] and Figure 3 teach the tuning for a period of time; Paragraphs [0035]-[0038] and Figure 3 teach the minimum number of user inputs is taught to be a period (P); When the number of inputs/periods(P) is set

to one then any time a user watches a program for at least five minutes as taught in Figure 3, the category the program corresponds to is given a value according to the formula detailed in paragraphs [0040]-[0043] thus a program is added to a second set (programs having number values) from a first set (all programs with no number values)); and

a second unit (Figure 1 element 32) coupled with the first unit to determine the demographic profile based on the second set (Paragraphs [0049] teach that parts of the invention can be implemented at a remote system/second unit).

Referring to claim 15, depending on claim 13, Knee teaches wherein the second unit is located at a head end of a broadcasting system (Paragraph [0049] and Figure 1).

Referring to claim 16, depending on claim 15, Knee teaches wherein the first unit is to transmit the second set to the second unit (Paragraph [0049] and Figure 1 teach a bidirectional connection between elements 44 and 32 and a second set/data relating to a user watching a program for at least a minimum period of time would have be transmitted from element 44 to element 32).

Referring to claim 17, depending on claim 15, Knee teaches wherein the first unit is to receive a set of advertisements, including the first advertisement, from the second unit (Paragraph [0049] and [0050] and Figure 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knee et al. (U.S. 2002/0095676 A1) in view of Ellis et al. (U.S. 2003002744 A1).

Referring to claim 14, depending on claim 13, Knee fails to teach the broadcasted program viewing device coupled with the first unit to display the first advertisement with an interactive programming guide.

In an analogous art Ellis teaches the broadcasted program viewing device coupled with the first unit to display the first advertisement with an interactive programming guide (Figure 3 teaches a first unit and Paragraphs [0125] and [0126] teach selecting an advertisement and Paragraph [0110] teaches using viewer history to determine which advertisements to use in the program guide, Figure 5 elements 108).

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined first and second category set method of Knee and using

the targeted advertisement display method of Ellis for the purpose of providing users' a user customized program guide experience (Paragraph [0010], Ellis).

Claims 1, 4, 5, 7, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClard (U.S. 6438752 B1) in view of Knee et al. (U.S. 2002/0095676 A1).

Referring to claim 1, McClard teaches a method comprising:

adding a category from a first set of broadcasted programs to a second set of categories of broadcasted programs in response to a broadcasted program viewing device being tuned, for a period of time at least equal to a first predetermined threshold, to at least one broadcasted program predetermined to be in the category from the first set (Column 4 lines 64-67 and Figure 3 element 54 teaches storing program category information in the memory and Column 5 lines 52-67 and Column 6 lines 1-9 teaches that when a program is watched for a period of time the program is added to a frequency watch list is memory 56 of Figure 3 and along with the program name the type/genre is added to memory 56 thus the category of a program is added from a first set of categories in memory 54 to a second set of data that includes categories in memory 56);

McClard fails to teach determining a demographic profile based on the second set; and selecting a first advertisement based on the demographic profile.

In an analogous art Knee teaches determining a demographic profile based on the second set (Paragraphs [0029] and [0030] and Figure 2 teach determining demographic categories for a user; Paragraph [0036] teaches that a shows category is used determine a users demographic profile); and selecting a first advertisement based on the demographic profile (Paragraph [0050] teaches determining an advertisement from the user demographic profile).

At the time the invention was made it would have been obvious for one skilled in the art to modify the category set moving method McClard using the demographic profiling and advertisement determination method of Knee for the purpose of categorizing user information into demographic categories that could then be used for specified purposes, such as for targeting advertisements or taking certain actions in the program guide (Paragraph [0007], Knee).

Referring to claim 4, depending on claim 1, Knee teaches receiving a set of advertisements including the first advertisement (Paragraph [0023]).

Referring to claim 5, depending on claim 1, Knee teaches removing a category from the second set in response to the broadcast program viewing device not being tuned for a period of time at least equal to a second predetermine threshold, to at least one broadcasting program predetermined to be in the category from the second set (Paragraph [0044]).

Referring to claim 7, see the rejection of claim 1; (McClard teaches Figure 3 teaches element 50 a processor and element 52 is memory according to Column 4 lines 54-61); Knee teaches Figure 1 and elements 64 memory and 60 a microprocessor according to Paragraph [0028]).

Referring to claim 10, depending on claim 7, see the rejection of claim 4.

Referring to claim 11, depending on claim 7, see the rejection of claim 5.

Claims 2, 3, 8, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClard (U.S. 6438752 B1) in view of Knee et al. (U.S. 2002/0095676 A1) further in view of Ellis et al. (U.S. 2003/0020744 A1).

Referring to claim 2, depending on claim 1, McClard and Knee fail to teach displaying the first advertisement with an interactive programming guide.

In an analogous art Ellis teaches displaying the first advertisement with an interactive programming guide (Paragraphs [0125] and [0126] teach selecting an advertisement and Paragraph [0110] teaches using viewer history to determine which advertisements to use in the program guide, Figure 5 elements 108).

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined methods of McClard and Knee using the targeted advertisement display method of Ellis for the purpose of providing users' a user customized program guide experience (Paragraph [0010], Ellis).

Referring to claim 3, depending on claim 1, McClard and Knee fail to teach transmitting the second set to a unit at a head end of a broadcasting system.

In an analogous art Ellis teaches transmitting the second set to a unit at a head end of a broadcasting system (Paragraphs [0125] and [0126] and Figure 2b teach transmitting the user history to the program guide server element 25).

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined methods of McClard and Knee using the transmission of recorded user history data to the head end of Ellis for the purpose of providing users' a user customized program guide experience (Paragraph [0010], Ellis).

Referring to claim 8, depending on claim 7, see rejection of claim 2.

Referring to claim 9, depending on claim 7, see rejection of claim 3.

Claims 5, 6, 11, 12 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over McClard (U.S. 6438752 B1) in view of Knee et al. (U.S. 2002/0095676 A1) further in view of Ohkura (U.S. 6128009).

Referring to claim 5, depending on claim 1, McClard and Knee fail to teach a second unit that is also to remove a category from the second set upon a selecting of the category from the second set.

In an analogous art, Ohkura teaches an EPG system wherein the second unit (24H Fig. 4) removes a category from a second set upon a selecting of the category from the second set (Column 28 lines 41-60).

At the time the invention was made it would have been obvious for one of ordinary skill in the art to modify the combined methods of McClard and Knee using the removal of a category method of Ohkura for the purpose of allowing the user to manually remove an undesirable category.

Referring to claim 6, depending on claim 1, McClard and Knee fail to teach verifying the adding of the category from the first set to the second set.

In an analogous art Ohkura teaches verifying the adding of the category from the first set to the second set (Column 32 lines 19-25 teaches checking to make sure categories have been moved from first set Figure 19 element 68 to the second set Figure 19 element 71).

At the time the invention was made it would have been obvious for one of ordinary skill in the art to modify the combined methods of McClard and Knee using the verification method of Ohkura for the purpose of notifying the user to hasten the registration (Column 32 lines 25-30, Ohkura).

Referring to claim 11, depending on claim 7, see rejection of claim 5.

Referring to claim 12, depending on claim 7, see rejection of claim 6.

Claims 13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al. (U.S. 6177931 B1) in view of McClard (U.S. 6438752 B1).

Referring to claim 13, Alexander teaches a system comprising:

a first unit (Column 5 lines 5-54) to select a first advertisement based on a demographic profile based on a second set of categories of broadcasted programs to which a category from a first set of categories of broadcasted programs was added to at least one broadcasted program predetermined to be in the category from the first set (Column 29 lines 30-55 teaches a viewer can watch a program and the type of theme/category of the program is recorded; All the programs and related data which includes program categories are received in a data download according to Column 8 lines 18-35 which make up a first set; the second set exists when a program is watched because the category of the program watched is determined by the EPG; Column 32 lines 35-67 and Column 33 lines 1-7); and

a second unit (Column 29 lines 30-34 teaches parts of the Profile Program can be distributed among the head end, Internet, or the EPG) coupled with the first unit to

determine the demographic profile based on the second set (Column 29 lines 56-67 and Column 30 lines 1-44).

Alexander fails to teach in response to a selecting of the category from the first set or a broadcasted program viewing device being tuned, for a period of time at least equal to a first predetermined threshold.

In an analogous art McClard teaches in response to a selecting of the category from the first set or a broadcasted program viewing device being tuned, for a period of time at least equal to a first predetermined threshold (Column 5 lines 52-65).

At the time the invention was made it would have been obvious for one skilled in the art to modify the program category system of Alexander using the minimum time period need to determine if a program should be record in the watch history system of McClard for the purpose of generating a statistical model of a viewer's preferences (Column 6 lines 9-15, McClard).

Referring to claim 15, depending on claim 13, Alexander teaches wherein the second unit is located at a head end of a broadcasting system (Column 29 lines 30-67).

Referring to claim 16, depending on claim 15, Alexander teaches wherein the first unit is to transmit the second set to the second unit (Column 29 lines 30-67).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter C. Wilder whose telephone number is 571-272-2826. The examiner can normally be reached on 8 AM - 4PM Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571)272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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